

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed April 7, 2006 ("Office Action"). In the Office Action, Claims 1-22 are pending and the Examiner rejects Claims 1-22. Applicants respectfully request reconsideration and favorable action in this case.

Rejections Under § 103

The Examiner rejects Claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,907,705 issued to Carter ("*Carter*") in view of U.S. Patent Application Publication No. 2002/0049962 issued to Kelbaugh et al. ("*Kelbaugh*").

A. Claims 1-22 are Allowable over the Proposed *Carter-Kelbaugh* Combination

Independent Claim 1, of the present Application, recites as follows:

An integrated electronic process for reviewing a development project to evaluate for potential defects in a product under development, comprising:

creating an evaluation review header identifying a peer review moderator, author and task leader;

creating a peer review team identifying the review team members and the roles of the author and the moderator;

identifying potential defects within the roles of the author, moderator and the review team members and generating a database record of potential defects;

performing a committee review of the database record of potential defects by the author, moderator and review team members to evaluate identified potential defects for acceptance or rejection;

removing the accepted potential defects from the database record of the potential defects;

entering the accepted potential defects into an action request database; and

confirming that accepted potential defects have been removed from the record of potential defects by completion of a rework action.

In the Final Office Action, the Examiner continues to rely upon the *Carter-Kelbaugh* combination to reject Applicants' Claim 1 under 35 U.S.C. § 103(a). Applicants respectfully

submit, however, that the *Carter-Kelbaugh* combination does not does not disclose, teach, or suggest each and every element of Applicants' Claim 1.

In the previous Response to Office Action submitted on December 30, 2005, for example, Applicants argued that the *Carter-Kelbaugh* combination does not disclose, teach, or suggest "performing a committee review of the database record of potential defects by the author, moderator and review team members to evaluate identified potential defects for acceptance or rejection," as recited in Applicant's Claim 1. Because the Examiner acknowledged (and continues to acknowledge) that *Carter* does not show the recited features and operations (Final Office Action, page 3), Applicants' arguments focused on the *Kelbaugh* reference. Specifically, Applicants showed that while *Kelbaugh* discloses a "product testing and bug tracking communications system which provides real time, virtually instantaneous, communication between a product developer, a product tester and others involved in getting a complex product to market" (Page 1, paragraph 1), the system of *Kelbaugh* does not include **"performing a committee review of the database record of potential defects by the author, moderator and review team members to evaluate identified potential defects for acceptance or rejection,"** as recited in Applicant's Claim 1.

As previously shown, *Kelbaugh* describes that "a user enters the bug tracking system uniform resource locator (URL) (52)" and signs on with "the user's assigned ID and password." (Page 4, paragraph 92). "Based upon the entered user's ID and password, a database is then accessed which results in the display of a home page/main menu tailored to the specific user's task in the software generation process." (Page 4, paragraph 92). "For example, the displayed home page identifies the user as being a tester, project coordinator, translator, developer, or corporate contact." (Page 4, paragraph 92). In operation, "a tester would access the bug queue in order to enter specific information . . . with respect to discovered bugs." (Page 4, paragraph 97). Thus, any discovered bugs are stored in a bug queue after being identified by the tester.

After the bugs are entered in the queue, "[t]he project coordinator then accesses the system" and "views bugs in the queue, then modifies and/or accepts them and the bugs are then placed into the master bug log." (Page 4, paragraph 99). Stated differently, "[a]fter a project coordinator reviews the bug queue and decides to "publish" bugs for viewing by developers,

such a bug may be entered “into a master bug log.” (Page 4, paragraph 97). The master bug log “includes only those bugs that have been accepted after being placed in a bug queue.” (Page 4, paragraph 99). Because *Kelbaugh* discloses that only the project coordinator reviews the bug queue in order to accept or reject bugs, *Kelbaugh* does not disclose, teach, or suggest “performing a **committee review** of the database record of potential defects **by the author, moderator and review team members** to evaluate identified potential defects for acceptance or rejection,” as recited in Claim 1. In fact, *Kelbaugh* further discloses that “[w]hen a tester accesses the bug queue, the accept publish, and reject functions . . . are not shown since these functions are used by project coordinators to accept bug for the master bug log, publish the bug for developers or reject the bug entered by an individual tester.” (Page 6, paragraph 110). Accordingly, the tester of the *Kelbaugh* system cannot be said to participate with the project coordinator in the “perform[ance of] a committee review of the database record of potential defects by the author, moderator and review team members to evaluate identified potential defects fro acceptance or rejection,” as recited in Applicants’ Claim 1.

In the Final Office Action and in the Office Action before it, the Examiner relies specifically on paragraph 97 on page 4 of *Kelbaugh* for disclosure of the recited features. That portion of the reference merely states:

The tester would access the bug queue in order to enter specific information as will be detailed below with respect to discovered bugs. After a project coordinator reviews the bug queue and decides to “publish” bugs for viewing by developers, such a bug may be entered into the master bug log.

Thus, the cited portion of *Kelbaugh* actually supports Applicants’ arguments made above. Because *Kelbaugh* discloses only that the “project coordinator reviews the bug queue,” the relied upon portion of *Kelbaugh* cannot be said to disclose, teach, or suggest “performing a **committee review** of the database record of potential defects **by the author, moderator and review team members** to evaluate identified potential defects for acceptance or rejection,” as recited in Claim 1.

Furthermore, Applicants respectfully submit that, in the Final Office Action, the Examiner has failed to address Applicants' arguments with respect to *Kelbaugh's* failure to disclose, teach, or suggest "performing a committee review of the database record of potential defects by the author, moderator and review team members to evaluate identified potential defects for acceptance or rejection," as recited in Claim 1. These arguments were first presented in the Response to Office Action mailed December 30, 2005, but have not been responded to in the Final Office Action. Rather, in the Final Office Action, the Examiner merely reproduces (very nearly word-for-word) the Examiner's previous rejection of Applicants' claims.

Section 707.07(f) of the M.P.E.P. requires an Examiner to answer all material traversed by an Applicant. Specifically, that provision states:

Where the applicant traverses any rejection, the examiner should if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

(M.P.E.P. § 707.07(f)). Because the Examiner has failed to respond to Applicants' arguments disputing that *Kelbaugh* discloses, teaches, or suggest Applicants' steps of "performing a committee review . . . ," as recited in Claim 1, Applicants submit that the Office Action is deficient on its face.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1.

The Examiner also relies on the *Carter-Kelbaugh* combination to reject independent Claims 8 and 17. Applicants respectfully submit, however, that the *Carter-Kelbaugh* combination does not disclose, teach, or suggest each and every element of Applicants' independent Claims 8 and 17. For example, Claim 8 recites "performing a committee review of the potential defects by the author, moderator and review team members to evaluate identified potential defects for acceptance or rejection." As another example, Claim 17 recites "generating a defects report from a committee review of the potential defects by the author, moderator and review team members, the report identifying potential defects for acceptance or rejection" Thus, for reasons similar to those discussed above with regard to Claim 1, Applicants

respectfully submit that the *Carter-Kelbaugh* combination does not disclose, teach, or suggest each and every element set forth in Applicants' independent Claims 8 and 17.

Dependent Claims 2-7, 9-16, and 18-22 depend upon independent Claims 1, 8, and 17, respectively, which Applicants have shown above to be allowable. Accordingly, dependent Claims 2-7, 9-16, and 18-22 are not obvious over the various combinations of references relied upon by the Examiner at least because Claims 2-7, 9-16, and 18-22 include the limitations of their respective independent claims. Since Claims 2-7, 9-16, and 18-22 incorporate the limitations of their respective independent claims, Applicants have not provided detailed arguments with respect to Claims 2-7, 9-16, and 18-22. However, Applicants remain ready to do so if it becomes appropriate. Applicants respectfully request reconsideration and allowance of Claims 2-7, 9-16, and 18-22.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 1-22.

B. The Proposed *Carter-Kelbaugh* Combination is Improper

Furthermore, Applicants respectfully submit that the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicants' invention to modify or combine *Carter* with *Kelbaugh* in the manner proposed by the Examiner. Applicants' claims are allowable for at least this additional reason.

1. The Legal Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* ***Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.”*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, ***“The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the***

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

basis of the facts gleaned from the prior art." M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.* Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

2. The Analysis

With regard to independent Claims 1 and 8, the Examiner states that "it would have been obvious to a person of ordinary skilled in the art at the time of the invention to identify, review, and modify potential defects from a database of potential defects to *Carter's* invention." (Office Action, page 4). The purported motivation provided by the Examiner is "providing a product testing and bug tracking apparatus, which advantageously permits a twenty-four hours day, seven days a week, communication capability between game testers, project coordinators, game developers and others involved in the testing and debugging process. (Kelbaugh: Col

1:0007).” (Office Action, pages 4-5). The Examiner makes a similar statement with regard to independent Claim 17. It appears that the Examiner has merely proposed alleged an advantage of combining *Carter* with *Kelbaugh* (an advantage which Applicants do not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has touted an advantage of *Kelbaugh*, the Examiner has not pointed to any portion(s) of the either reference that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the software release stream of *Carter* with the bug queue - master bug list configuration disclosed in *Kelbaugh*. In other words, the alleged advantage of the system disclosed in *Kelbaugh* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicants’ invention (***without using Applicants’ claims as a guide***) to modify the particular techniques disclosed in *Carter* with the cited disclosure in *Kelbaugh*; (2) how one of ordinary skill in the art at the time of Applicants’ invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claims 1, 8, and 17. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

It certainly would not have been obvious to one of ordinary skill in the art at the time of invention ***to even attempt*** to, let alone ***to actually***, modify or combine the particular software release stream of *Carter* with the bug queue - master bug list configuration disclosed in *Kelbaugh* in the manner proposed by the Examiner.² Applicants respectfully submit that the Examiner’s attempt to modify or combine *Carter* with *Kelbaugh* appears to constitute the type of impermissible hindsight reconstruction of Applicant’s claims, using Applicant’s claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

² If “common knowledge” or “well known” art is relied upon by the Examiner to combine or modify the references, Applicants respectfully request that the Examiner provide a reference pursuant to M.P.E.P. § 2144.03 to support such an argument. If the Examiner relies on personal knowledge to supply the required motivation or suggestion to combine or modify the references, Applicants respectfully request that the Examiner provide an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Carter* with *Kelbaugh* in the manner the Examiner proposes, Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicants respectfully submit that the rejection must therefore be withdrawn.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 1-22.

CONCLUSION

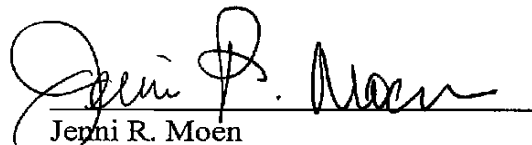
Applicants have made an earnest attempt to place this application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorneys for Applicants, at the Examiner's convenience at (214) 953-6809.

Applicants believe that no fees are due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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